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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/461,738	12/16/1999	HIROOMI MOTOHASHI	0557-4875-2	4201
22850	7590	03/17/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			WALLERSON, MARK E	
			ART UNIT	PAPER NUMBER
			2626	

DATE MAILED: 03/17/2004

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/461,738

Applicant(s)

MOTOHASHI ET AL.

Examiner

Mark E. Wallerson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 09 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 7-15,22-27,34-40 and 53-55 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 7-15,22-27,34-40 and 53-55 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 13, 14, 15.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Part III DETAILED ACTION

Notice to Applicant(s)

1. This action is responsive to the following communications: amendment filed on 12/19/03.
2. This application has been reconsidered. Claims 7-15, 22-27, 34-40, and 53-55 are pending.

Information Disclosure Statement

3. The references listed in the Information Disclosure Statements dated 12/16/03; 12/23/03; and 1/27/04 have been considered by the Examiner and is attached to this Office Action.

Claim Objections

4. Claims 9 and 40 are objected to because of the following informalities: “[S]alve” should be changed to “slave”. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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7. Claim 10 recites the limitation "the non-executable function" in the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371⁹ of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. Claims 7, 9, 22, 24, 25, 27, 34, 35, 36, 37, 38, 39, 40, 53 and 55 are rejected under 35 U.S.C. 102(e) as being anticipated by Kitamura et al (Kitamura) (U. S. 6,400,463).

With respect to claims 7, 22, 25, 34, 36, 38, and 53, Kitamura discloses an image formation system (figure 1) having a link copy mode (the abstract) in which a plurality of image forming apparatuses connected to each other for enabling data communications (1001-1004), an image formation apparatus (1001) functioning as a master machine reads an image of a document to be copied (column 19, lines 27-50), the read image is transmitted to at least one

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other image formation apparatus functioning as a slave machine and printing of the reads image is shared by the master and slave machine (column 19, lines 27-50 and column 21, lines 6-10), wherein the slave machine reports the slave machine reports the functions available in the slave machine to the master machine (column 5, lines 14-37), and the master machine inhibits the operation in the link copy mode when the link copy and a non-executable function (short of paper) is selected (column 20, line 60 to column 21, line 5).

Further with respect to claims 22 and 25, Kitamura discloses a mode for executing a non-executable (short of paper) is cancelled when the link copy mode is selected (column 20, line 60 to column 21, line 5).

Further with respect to claim 36, Kitamura discloses an image read and transferred from the other image formation apparatus is printed in the local image forming apparatus (column 7, lines 50-60 and column 18, lines 28-36).

With regard to claims 9, 24, 27, 35, 37, 40, and 55, Kitamura discloses the master image forming apparatus is connected to the other image forming apparatus peer to peer (which reads on master to slave) (figure 1).

With respect to claims 39 and 54, Kitamura discloses the slave machine periodically transmits a connection signal to the master machine and the master machine receives the signal and determines whether the slave machine is ready for communication (column 5, lines 22-37).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 8, 23, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitamura in view of Nakai et al (Nakai) (U. S. 6,081,342).

With respect to claims 8, 23, and 26, Kitamura differs from claims 8, 23, and 26 in that he does not clearly disclose the function includes stapling. Nakai discloses an image forming system wherein plural image forming apparatuses transmit image data to each other and the functions of the image forming apparatus includes stapling (figure 8(b)). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kitamura wherein the function includes stapling. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kitamura by the teaching of Nakai in order to improve the efficiency of the system.

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 10, 12, 13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitamura in view of Sugishima et al (Sugishima) (U.S. 4,797,706).

With respect to claims 10 and 13, Kitamura discloses an image forming apparatus (1001) connected to at least one other image forming apparatus (1002-1004) such that communication can be executed between the two image forming apparatuses (the abstract) comprising a reading

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unit (351) which reads an image of a document; a printing unit (352) which prints the read image; a display unit (figure 6) which displays keys used for selecting a function; a controller (603) which executes a link copy mode in which the read image is transferred to the other image forming apparatus for sharing of the printing of the read image (column 21, lines 6-10).

Kitamura differs from claims 10 and 13 in that he does not clearly disclose that if the link mode is selected, then a key for selecting a non-executable function is not displayed.

Sugishima discloses a multi-unit image processing system wherein when the link mode (multi mode) is selected, then a key for selecting a non-executable function (paper size not set in the printers) is not displayed (column 18, lines 12-18). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kitamura wherein if the link mode is selected, then a key for selecting a non-executable function is not displayed. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kitamura by the teaching of Sugishima in order to more effectively utilize the plural readers, so that if any printer is not available, the cause for this can be clearly determined and countermeasures can be taken immediately as disclosed by Sugishima in column 25, lines 27-30.

With regard to claim 12 and 15, Kitamura discloses the master image forming apparatus is connected to the other image forming apparatus peer to peer (which reads on master to slave) (figure 1).

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 11 and 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kitamura in view of Sugishima as applied to claim 10 above, and further in view of Nakai.

With respect to claims 11 and 14 Kitamura as modified differs from claims 11 and 14 in that he does not clearly disclose the function includes stapling. Nakai discloses an image forming system wherein plural image forming apparatuses transmit image data to each other and the functions of the image forming apparatus includes stapling (figure 8(b)). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kitamura as modified wherein the function includes stapling. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kitamura as modified by the teaching of Nakai in order to improve the efficiency of the system.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Wallerson whose telephone number is (703) 305-8581.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, DC 20231

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or faxed to:

(703) 872-9314 (for formal communications intended for entry)

(for informal or draft communications, such as proposed amendments to be discussed at an interview;
please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two

2121 Crystal Drive

Arlington, VA.

Sixth Floor (Receptionist)

MARK WALLERSON
PRIMARY EXAMINER



MARK WALLERSON